In the Supreme Court of the United States

OCTOBER TERM, 1894.

No. 208.

HERBERT H. WAXHAM, doing business as
WAXHAM HATCHERIES,
Petitioner,

vs.

SAMUEL E. SMITH and THE BUCKEYE INCUBATOR COMPANY,
Respondents.

RESPONDENTS' BRIEF

IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE NINTH CIRCUIT.

ALBERT L. RAY,
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STATEMENT OF CASE.

This is an action brought by Samuel B. Smith and The Buckeye Incubator Manufacturing Company against a user of what is known as the "Robbins Incubator." The only claim in issue is process Claim 1, and the only disagreement between the Eighth and the Ninth Circuits is upon the scope of this claim. The question involved in this contrariety of opinion is whether infringement of the process claim is avoided by arranging the eggs in a different order as to their ages or degrees of incubation from the specific order shown in the Smith patent.

We believe that a Writ of Certiorari should be granted and that the issue should be confined to this single question. There is no contrariety of opinion between the several Circuits which have passed upon this patent upon any other

question. Reference is made to the copending application for Writ of Certiorari to the Circuit Court of Appeals of the Eighth Circuit, filed by the Respondent here, in the case of *Smith v. E. H. Snow, et al.*, No. 102, in which the Smith patent is more fully discussed.

Point A.—The Conflict Between the Eighth and Ninth (and Other) Circuits, Relates to the Effect of Egg Arrangement Upon Infringement.

The conflict of opinion between the Eighth and Ninth Circuits is sharply defined by the following quotations from the respective opinions.

In the *Snow* case* the Eighth Circuit, while holding specifically that if claim 1 were "given the full scope of its expression it covers the accused device" said:

> "it is difficult to see how the desired results can be secured except by a current of air passing first through the trays containing the most advanced eggs."

and

> "Thus differing in both essentials of the patent—arrangement of eggs and air current—from the device disclosed by the patent, appellants' device is not infringing."

The Ninth Circuit in the instant case, in which the same air current generating means and the same indiscriminate arrangement of eggs, as in Snow, were employed, said (R. p. 681):

> "The appellant seeks to avoid the claim of infringement by reason of the fact that the eggs in his machine are not placed in a single column with the fresh eggs at the top and eggs which are hatching at the bottom, but are distributed through the chamber without any endeavor to place them in this exact rela-

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* *E. H. Snow et al. v. Smith*, 70 F. (2) 564.

tionship. This difference is clearly immaterial where the air in a chamber is kept at a constant and uniform temperature and rapidly circulated. The result of currents of air moving with high velocity would be to transfer heat from the older eggs to the fresher and colder eggs in either event. The important thing is the high velocity of the air current, avoiding stagnation in the immediate vicinity of the eggs in later stages of incubation."

The patent has also been before the Third and Sixth Circuits. In every instance the patent has been held valid. In each instance the patent has been held to cover a process in which eggs in various stages of incubation have been subjected to a current of air passing over the eggs, the Eighth Circuit only requiring that the eggs must be arranged in the exact order shown in the Smith patent. The other Circuits have held that conformity with this specific order is neither required by the claims, nor essential, to obtain the benefits of the Smith invention. As the air moves in continuous recycling currents, or in an endless circuit through the eggs in the Smith patent, the Sixth Circuit, in the *Blum* case,* the Third Circuit, in the *Hillpot* case,** and the Ninth Circuit, in the instant case, have held that the order and shifting of eggs is immaterial to the accomplishment of Smith's conception, i.e., the equalization of temperature between the old, hot eggs and the new, fresh eggs—or, as stated in the claim, the transference of heat units from the eggs in the more advanced stage to those in a less advanced stage.

On this point the Court of Appeals of the Eighth Circuit erred, holding with the earlier expressed doctrine of the Sixth Circuit in the *Petersime* case,*** later corrected in the *Blum* case.

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* *Buckeye Incubator Co. v. Blum*, 27 F. (2) 333;
** *Buckeye Incubator Co. v. Hillpot*, 24 F. (2) 341;
*** *Buckeye Incubator Co. v. Petersime*, 19 F. (2) 721.

The Petitioner admits on page 7 of the Petition filed in this case, that this is "the principal question of infringement and constitutes the main point of difference of construction of the claim among the various Circuits." In reply, this is not the "principal question" of dispute between the Circuits,—it is the *only* question in dispute.

Point B.—There is No Disagreement Between the Various Circuits Upon the Process Claim in Suit Based Upon Variations in Apparatus, Such as the Presence or Absence of the Curtains.

The Petitioner seeks to raise a second question upon which there is no conflict. This issue is based upon distinctions between the *apparatus* shown in Smith and that employed by Waxham (Robbins).

It is to be noted that the claim in issue is for a process or method of incubation. It is well established that, in treating a claim directed to a *process*, the details of apparatus, by which the process is performed, are quite immaterial.

Thus the Supreme Court in *Cochrane v. Deener*, 94 U. S. 780-788 said:

> "A process is a mode of treatment of certain materials to produce a given result. It is an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing. If new and useful, it is just as patentable as is a piece of machinery. In the language of the patent law, it is an art. *The machinery pointed out as suitable to perform the process may or may not be new or patentable*; whilst the process itself may be altogether new, and produce an entirely new result. The process requires that certain things should be done with certain substances, and in a certain order; but *the tools to be used in doing this may be of secondary consequence.*" (Italics ours.)

and as stated in *Tilghman v. Proctor,* 102 U. S. 707-735:

> "Perhaps the process is susceptible of being applied in many modes and by the use of many forms of apparatus. The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process. * * * It only remains that we should express our views on the question of infringement. The defendants advance several reasons for the purpose of showing that their process does not conflict with Tilghman. First, because they do not use the apparatus described in the complainant's patent."

In that case infringement was found, notwithstanding the differences in apparatus.

In *Carnegie v. Cambria,* 185 U. S. 403-441, this Court said:

> "It" (a process patent) "professes to disclose a method of procedure, not the particular instrumentality that may be employed."

and in *Leeds & Catlin v. Victor Talking Machine Co.,* 213 U. S. 301-318:

> "*A process and an apparatus by which it is performed are distinct things. They may be found in one patent*; they may be made the subject of different patents." (Italics ours.)

None of the Circuit Courts of Appeals have expressed opinions at variance with this established rule, nor held that the presence of such details of Smith's *apparatus,* as the curtains on either side of the corridor, were essential to infringement of the *process.* It is evident that, while curtains may direct a feeble current such as would be generated by the small fans shown in the Smith patent, by increasing the power of the fans and the velocity of the air stream propelled therefrom, a current of air would be generated which would persist throughout the cabinet without the use of any mechanical guiding or directing means.

Point C.—The Various Circuits Are In Agreement That Claim 1 is Infringed if a Current Movement of Air is Found, and Petitioner Has Admitted That He Employs Currents of Air.

The Sixth Circuit in the *Blum* case said (27 F. (2) 333):

> "the patent contemplates a distinct, or at least an identifiable, current of air, flowing like a stream in one direction.".

and this has been accepted in all cases.

In the *Hillpot* case, referred to by the Petitioner, the Court of Appeals of the Third Circuit said (24 F. (2) 341-344):

> "The essence of the invention therefore is forced circulation of heated air in predetermined direction"

and again (p. 345):

> "On circulation by defined currents alone Smith was awarded the patent. We cannot find circulation of that kind in any of the Hillpot structures. With curtains off, the tiers of trays present comb fronts to the passageway. When the warm air leaves the fan there is for a moment and for a short distance a current, but as the force weakens the current fades, and the body of heated air does not go to the opposite wall and mushroom but wanders in between each of the scores of trays and goes where it pleases. Instead of one strong current moving in one direction in trunk form, Hillpot has a trunk current only on leaving the fan; then it divides into a multitude of branches which follow no defined courses but only courses made by the least resistance. We are constrained to find that Hillpot did not infringe the claims of the Smith patent in suit."

The Ninth Circuit held that the Robbins incubator employed these same currents of air, a finding of fact and not a conclusion of law: and they applied the law in exactly

the way in which it had been applied in the other cases, saying (Rec. p. 681):

> "There is a definite and continuous current of air utilized in the Waxham device moving at a velocity not materially different from the speed of the air current in the Smith patent and accomplishing substantially the same purpose."

In fact, the defendant in the *Waxham* case specifically admitted that the air in the Robbins machine moved in defined, definite current form. This was fully demonstrated by Robbins himself, as is shown by Plaintiffs' Exhibit 17, a copy of certain affidavits filed by Robbins in another suit brought against him by the owner of a patent presumably directed to the agitation of air in an incubator. In this affidavit engineers, *employed by Robbins,* proved that Robbins employed "appreciable air currents * * * produced and maintained as a necessary result of the large fan in the rear" (Rec. Vol. 2, p. 30; and again on page 31):

> "there is appreciable and well defined current circulation in all parts of the Robbins machine."

on page 38:

> "in the Robbins incubator the air currents are positive and continuous."

and on page 53:

> "the air movements are in general, in definite lines or paths."

Attention is also directed to diagram (Ex. 17, Rec. p. 62) showing the flow of the air through the Robbins machine, which diagram was prepared by Robbins in the Petersime litigation (*Robbins v. Petersime,* 51 F. (2d) 174) specifically for the purpose of demonstrating that, in the Robbins incubator, the air was not agitated and, therefore, did not infringe upon the Petersime patent, which was subsequent to the Smith patent. As was stated by the Ninth Circuit (Rec. pp. 681-682):

> "The appellant relies upon the decision of the Circuit Court of Appeals in the *Petersime* case where it was held that a device which merely agitated the air in the incubating chamber did not infringe the Smith patent. We are not concerned with such a device in this case."

The Smith patent has been held in the *Hillpot* case to be limited to the use of a "current" of air passing through the eggs. The Court of Appeals of the Ninth Circuit found current movement of air in the Robbins incubator. There is, therefore, no disagreement between the Ninth and the Third Circuits, contrary to the statement at page 9 of the petition.

Nor, as we have pointed out in the quotation above from the *Blum* case, did the Sixth Circuit hold any contrary opinion and there is no disagreement between the Ninth and the Sixth Circuits on this point.

Nor was there any variation from the position taken in the *Blum* case, in the later *Boling* case.* In the *Boling* case the Sixth Circuit, at the end of the opinion, said:

> "Whether infringement is avoided in the present devices by the lack of a *sufficiently well-defined* current or cycle of air, or by the direction in which the air is propelled, or by the fact that the heated air first contacts the eggs in the less advanced stages of incubation, we expressly refrain from deciding." (Italics in original.)

To allege, as Petitioner alleges on page 11, that the "closed corridor" is the test of infringement, is placing an erroneous interpretation upon the holding of the various Circuits, and is equivalent to charging those Courts with determining the question of infringement of a process claim by reference to detailed structural or apparatus features. The well-settled rule is that, in determining infringement of process claims, details of apparatus are im-

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* *The Buckeye Incubator Company et al. vs. Boling,* 46 Fed. (2) 965.

material, and we can not concede that the Circuit Courts have overlooked this controlling law.

We note at the top of page 12 of the Petition, the admission that the air moves from the fans as a stream, and that it returns to the fans in "broken up currents." The only thing which would separate or divide the current of air in the Robbins incubator is the egg trays in the path of that current; and the operation of the Smith incubator differs in no respect therefrom, as Smith places his trays in the path of the current of air, and it is broken up thereby, just as the returning air current in Robbins is "broken up."

Petitioner is compelled to admit that, in the Robbins incubator, the air moves in current form.

Point D.—The Test of Infringement is Whether There is an Interchange of Heat Between the Old, Hot (Exothermic) Eggs and the New, Cold (Endothermic) Eggs.

We have gone into this subject fully in the Petition for Writ of Certiorari in the *Snow* case, and will not enlarge upon that subject fully here, referring to that case for a full discussion of our position.

Briefly stated, the air in the Smith incubator moves in closed, endless cycles. The fan is merely the instrumentality which maintains the current in motion. It can make no difference with respect to the function of that air current as a medium for heat transfer, or, as expressed in the claim, the carrying of heat units from hot to cold eggs, where the hot and cold eggs are located in the endless air cycles. The Third Circuit was the first to give expression to this fact in the *Hillpot* case (p. 344, 24 F. (2d) 341):

> **"But when, as in Smith, the air moves in cycles through corridor and tiers it makes no difference after the first cycle which way it moves through the egg**

> **trays, whether from bottom to top or from top to bottom, or whether it first strikes warm eggs or first strikes cool eggs, for in every cycle after the first the current when passing warm eggs will gather up their heat units and carry them to the cool eggs precisely as claimed and will in the same way produce that uniformity of temperature which is the thing sought by the art and achieved by the invention.''**

Nor, as pointed out by the same Court in the portion of the opinion immediately above the quotation (p. 343) is there any limitation in claim 1 as to the order of egg arrangement.

> ''The part with which we are first concerned is whether, as Hillpot urges, the claims must be held limited to a method which calls not only for a current of heated air driven in a defined direction through a column of eggs but also for a current which will first come in contact with warm eggs—those 'in the more advanced stage of incubation'—and then picking up additional thermal units pass on and carry them to the cool eggs—those 'in a less advanced stage.' Undoubtedly that is the preferred method described and, certainly, that is the working of the apparatus of claim 4, not of the apparatus of claim 5. *But it is not the working of the methods defined by claims 1 and 2 for they are not so limited in terms.*'' (Italics ours.)

The Sixth Circuit in the *Blum* case agreed with this holding when, in referring to its earlier decision in the *Petersime* case, it said (27 F. (2) 333):

> ''In that opinion some acceptance was given to the theory that there is no infringement, unless the circulating air strikes first those eggs which are in the last stages of incubation and are generating the greatest heat. In considering a construction where the main current of air is brought in from outside, and in thinking of only the first circuit which this air makes, that thought seems applicable.

Counsel now point out, with much force, that in a case where the air does not come in from the outside in large volume, and that in any case during the circuits after the first one, no one point in the circuit gets the air ahead of any other point, in an absolute way. Which point gets it first depends upon where we consider the circuit to begin. We think we need not consider the effect of this defect in the reasoning—if it is a defect—of our former opinion.''

The Ninth Circuit was in agreement with the opinions in the Third and Sixth Circuits. It was able to see that, with the air moving in continuous cycles over all the eggs, the essential equalization of temperature was bound to take place with *any* arrangement of eggs, and that it was necessary neither to establish the specific order of egg arrangement described in the specification of the Smith patent, nor to shift the eggs during the process to maintain that order. As that Court said:

> ''The result of currents of air moving with high velocity would be to transfer heat from the older eggs to the fresher and colder eggs in either event.'' (Rec. p. 68.)

Point E.—The Eighth Circuit Alone Has Failed to Understand That the Heat Interchange Will Occur With Any Order of Egg Arrangement.

This is quite apparent from the statement at the close of the opinion in the *Snow* case upon which the Eighth Circuit based its findings of non-infringement. That Court said:

> ''it is difficult to see how the desired results can be secured except by a current of air passing first through the trays containing the most advanced eggs.''

It was upon this confessed inability to understand the logical result of the recycling currents of air, that the Eighth Circuit found for the defendant in the *Snow* case.

Point F.—In the Instant Case the Defendant Has Specifically Admitted That Neither the Order of Egg Arrangement Nor the Non-Shifting of the Eggs During the Process Affect the Results.

Robbins' expert, Mr. Fouts, admitted on cross-examination that the arrangement of eggs made no difference in the results, saying (Rec. p. 247):

> "As the air moves in a continuous cycle through the eggs, the direction of the air is of no moment to obtain the broad result that you have stated here.
>
> The order in which the eggs are placed in the different stages of incubation in that current of air for the transfer of heat is immaterial in the practical operation of the Smith machine, although I do not see that it makes much difference after the thing gets going once."

As to the shifting of the eggs during the process, the expert also admitted that that was also immaterial (p. 247):

> "Q. Then, as a matter of fact it is not necessary to move the eggs but just to place them so that you have eggs in varying stages of incubation in that column of air or in that current of air? That is correct, isn't it?
>
> A. I think that is correct; yes."

THE REASONS RELIED ON FOR ALLOWANCE OF THE WRIT ANSWERED.

Answering the five reasons, beginning at the bottom of page 12 of the petition, Respondent says:

1. The decision of the Ninth Circuit is in conflict with the decision of the Eighth Circuit on one point only, i.e., the egg arrangement. It is not in conflict with the Third and Sixth Circuits on this or any other point.

2. Ground 2 constitutes no ground for Writ of Certiorari in this case. No conflict of decisions is cited and none exists. This ground attacks the validity of the claim

as functional. It is not functional, and no Court has held it to be so. Every Circuit has held the patent valid.

3. Ground 3, set up in this section of the Petition, states no ground for consideration by this Court. Each and every Circuit has held that the file-wrapper proceedings limit Smith to the use of "current" movement of air as distinguished from agitation merely. It was so held specifically by the Sixth and Third Circuits, and the Ninth Circuit did not question this holding, but having found that Robbins used current movement of air, found infringement. There is no conflict in respect to this ground.

4. No conflict is stated in ground 4, unless this ground is based upon the order of egg arrangement.

5. For the reasons fully stated both in this and in the *Snow* case, we believe a writ should be issued to settle the troublesome question of the effect of egg arrangement upon infringement. This question, and this only, affords any conflict.

ANSWER TO "SPECIFICATION OF ERRORS."

On page 16 of the Brief in Support of the Petition, three errors are alleged. Of these that numbered 2 only, is the subject of conflict. Errors 1 and 3 relate to the validity of the patent. There has been no conflict of opinion on these questions. As the sole reason for granting the writ in this case would be conflict of opinion, this petition shoud be dismissed as to grounds 1 and 3. (*Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U. S. 387-388.)

ARGUMENT.

Replying specifically to the "Argument," we note that the Petitioner claims that "Smith describes and makes essential the progressive downward shifting," etc. Smith *describes* this as the desirable procedure *but he does not make it essential,* for this step is not in the claim in suit. The Petitioner also says that the "function" specified in claim 1 is performable only with the apparatus described in the specification. This contention overlooks two primary rules of patent construction; first, that in construing a *process* claim, apparatus is secondary and a valid process claim may be performed by apparatus wholly unlike the apparatus shown in the patent; and secondly, that the claim determines the scope of the patent and is controlling, not the description in the specification. As said by this Court in the *Paper Bag Patent Case,* 210 U. S. 419:

> "The invention, of course, must be described and the mode of putting it to practical use, *but the claims measure the invention.*"

The argument that the claim is functional or merely directed to the function of the apparatus is directed to the *validity* of the patent, a point concerning which no conflict has ever arisen.

The statements on page 19 of the petition, that the file-wrapper of the Smith patent limits the patent to a specific order of egg arrangement or to the provision of the closed corridor, are untrue. The Circuits have held that the patent is limited to current movement of air as opposed to agitation, but that question is of no moment here, for, as shown above, Robbins admitted and was found to employ current movement of air. The so-called "terminal portion" of the claim is directed to the transfer of heat units, a result which, for the reasons stated, will follow in any order of egg arrangement, so long as the closed

cycle movement of air characteristic of Smith is maintained.

We note again on page 22 that the Petitioner claims that he does not use "the indispensable structure of the patent." This is a mere evasion, for the issue is not whether Petitioner uses Smith's apparatus but whether the Robbins' incubator does not, in fact, carry on the process of claim 1. The fact that Robbins may have secured a patent upon the particular mechanism which he employs does not have any significance in weighing the question of infringement of Smith's *process* claim.*

**Ashley v. Weeks-Numan Co.*, 220 F. 899-903;
Temco v. Apco Co., 275 U. S. 319;
Cochrane v. Deener, 94 U. S. 780;
Herman v. Youngstown Car Mfg. Co., 191 F. 579 (C. C. A. 6);
Freeman v. Altvater, 66 F. (2) 506-512 (C. C. A. 8);
Simplex Window Co. v. Hauser Reversible Window Co., 248 F. 919-921 (C. C. A. 9).

CONCLUSION.

For the reasons stated we believe that the Writ of Certiorari should be granted, *but the questions in issue should be restricted both in this case and the Snow case to the single point upon which alone the conflict of opinion is based, i.e., the effect of egg arrangement upon infringement.*

Respectfully submitted,

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